



IN THE UNITED STATES PATENT & TRADEMARK OFFICE

RESPONSE AFTER FINAL REJECTION
EXPEDITED EXAMINING PROCEDURES

In re Patent Application of:

Michael Colin BEGG Atty. Ref.: LSN-34-125
Serial No.: 10/812,917 T.C./A.U.: 3729 – Conf. No.: 5698
Filed: March 31, 2004 Examiner: Anthony Dexter Tugbang
For: MANUFACTURE OF SHIM WINDINGS

* * * * *

July 16, 2009

MAIL STOP AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

SUPPLEMENTAL SUBMISSION OF AUTHORITIES

Further to the response filed July 9, 2009, applicant hereby brings the Examiner's attention to a recent Federal Circuit *en banc* decision (copy attached) relevant to the restriction requirement made in this application:

Abbott Laboratories, et al. v. Sandoz, Inc., et al., Case No. 2007-1400,

and *Lupin Ltd., et al. v. Abbott, et al.*, Case No. 2007-1446 (Fed. Cir. *en banc* decision of May 18, 2009)

At pages 14-21, the Federal Circuit considers the proper interpretation of "product-by-process" claims – and holds that recited process steps are scope limiting. Accordingly, the Examiner's prior restriction requirement based on the assertion that the

Michael Colin BEGG
Serial No. 10/812,917
July 16, 2009

claimed product-by-process could be made by other processes than the recited
punching process is clearly erroneous. Withdrawal of same is requested.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By:

Larry S. Nixon

Larry S. Nixon
Reg. No. 25,640

LSN:lef

901 North Glebe Road, 11th Floor
Arlington, VA 22203-1808
Telephone: (703) 816-4000
Facsimile: (703) 816-4100